



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Patent Application of

SASAKI, et al.

Appln. No.: 09/516,176

Filed: March 1, 2000

Title: INK-JET RECORDING MATERIAL AND
INK-JET RECORDING METHOD

Group Art Unit: 1773

Examiner: H. Thi Le

* * * * *

December 6, 2002

REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT,
ISSUE OF NEW OFFICE ACTION AND RESET RESPONSE PERIOD

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Contrary to the Office Action dated September 30, 2002, the applicants have demonstrated to the Examiner that the subject application was filed under 35 USC 371. In order to confirm that the subject application was filed under 35 USC 371 and in accordance with the telephone conference between the Examiner and the undersigned on October 30, 2002, a copy of the Transmittal Request filed with this application on March 1, 2000, was faxed to the Examiner along with a fax cover letter (copies enclosed with this Request).

The heading of the Transmittal Request states that it is a "Request For Filing National Phase of PCT Application Under 35 U.S.C. 371...." Accordingly, this application was filed under Section 371.

The applicants thus asked the Examiner to correct the Office Action dated September 30, 2002 which states that this application was not filed under Section

Handwritten notes and stamps: "11/12/02", "RECEIVED", "DEC-9 2002", and "TO 1700 MAIL ROOM".

371. The applicants further asked the Examiner to proceed to consider the restriction requirement under the PCT rules.

Based upon the Examiner's consideration of the above described faxed papers, the Examiner suggested that the applicants file a formal Request for reconsideration of the restriction under Section 371, enclosing the above described papers that were faxed on October 30, 2002. The Examiner would then reconsider the restriction requirement under PCT Rules and issue an appropriate new Office Action.

Accordingly, the applicants submit the present request with attachments and ask the Examiner to reconsider the restriction requirement in view of this application having been filed under Section 371. The need for a restriction requirement would thus be considered under the PCT Rules, and the "unity of invention" standard.

In this regard, please consider the following remarks which the applicants submit shows that no restriction requirement should be required under the PCT Rules.

The Examiner is asked to review the International Search Report (ISR) which issued for this application (Copy attached for the convenience of the Examiner). **The ISR shows that no lack of unity of invention was found in this application.**

As stated in MPEP 1844, the ISR must indicate whether the search was restricted or not for, among other reasons, "lack of unity of invention." In the present application, no lack of unit of invention was determined.

The Examiner is asked to review the International Preliminary Examination Report (IPER) which issued for this application (copy attached for the

convenience of the Examiner). **The IPER shows that no lack of unity of invention was found in this application.**

As stated in MPEP 1875, the Examiner may when preparing the IPER consider whether the international application complies with the requirement of unity of invention.

Further, 37 CFR 1.488(a) states that:

“Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in 37 CFR 1.475.”

Of paramount importance here, is the fact that the International Preliminary Examining Authority did not find a lack of unity. The Authority did not impose a restriction requirement.

MPEP 1875 points out that in most instances, lack of unity of invention will have been noted and reported upon by the International Searching Authority which will have drawn up the International Search Report. Thus, the unity of invention of the present application has been thoroughly investigated once and then thoroughly investigated again during preparation of 1) the International Search Report and 2) the International Preliminary Examination Report.

In the present application, no lack of unity of invention was determined during either of the two investigations.

Accordingly, the applicants request that no lack of unity of invention be found in the present application and all present claims be considered in this application. The applicants respectfully request that no restriction requirement be imposed.

Reconsideration of the restriction requirement, issue of a new Office Action with reset response period and favorable consideration of this application are respectfully requested.

Respectfully submitted,

MANELLI DENISON & SELTER, PLLC

By Paul E. White, Jr.

Paul E. White, Jr.

Reg. No. 32,011

Tel. No.: (202) 261-1050

Fax No.: (202) 887-0336

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Seventh Floor
Washington, D.C. 20036-3307
(202) 261-1000

**COPY OF FAX TO EXAMINER DATED
OCTOBER 30, 2002 WITH
ATTACHMENTS**



FROM
Manelli Denison & Selter, PLLC
Attorneys at Law
2000 M Street, 7th Floor, N.W.
Washington, DC 20036-3307

Telephone: 202-261-1050
Our Facsimile #: 202-887-0336

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TO: UNITED STATES PATENT AND TRADEMARK OFFICE

TO: **Examiner Hoa T. Le**
Art Unit: 1773

FACSIMILE #: (703) 872- 9610

No. Pages (Including this page) 4 FAX Opr: _____

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USPTO:

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ABOVE BY FAXING THIS PAGE BACK TO ONE OF OUR FACSIMILE
NUMBERS STATED ABOVE

In re PATENT APPLICATION of
Inventor(s) SASAKI et al.

Appln. No. 09/516,176

series code | serial no.

Filed: March 1, 2000

Group Art Unit: 1773

Examiner: Hoa T. Le

Atty. Dkt. PEW/46137

M#

TITLE: Ink-Jet Recording Material And Ink-Jet Recording Method Date: October 30, 2002

Name or type of paper being transmitted: Copy of Application Transmittal Papers
REQUEST FOR CERTIFIED COPY OF APPLICATION

MESSAGE:

Dear Examiner Le:

In accordance with our telephone conversation this evening, I enclose a copy of the transmittal request filed with this application on March 1, 2000. The heading states that it is a "Request For Filing National Phase of PCT Application Under 35 U.S.C. 371...." This application was filed under Section 371. Thus, please correct the Office Action dated September 30, 2002 which states that this application was not filed under Section 371, and proceed to consider the restriction requirement under the PCT rules.

Thank you.

Paul White

(ATTN: Atty/Sec.: Transmit only one paper herewith. For papers not acceptable by fax, see back side or LAN Forms Directory PAT-286 Rear. Do not file originals but fasten them in our file (left side) with this sheet and fax receipt on top. Do NOT send the originals nor a confirmation copy to the PTO.)

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Name Paul E. White, Jr. Sig. Paul E. White, Jr. Date October 30, 2002

Reg. No. 32,011

PEW/46137

C# / M#



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
REQUEST FOR FILING NATIONAL PHASE OF
PCT APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495

To: Asst. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

(Our Deposit Account No. 03-3975)

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TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)

Atty Dkt: PM 266297 /E4161-01C3
M# /Client Ref.

From: Pillsbury Madison & Sutro LLP, IP Group:

Date: February 29, 2000

This is a **REQUEST** for **FILING** a PCT/USA National Phase Application based on:

1. International Application	2. International Filing Date	3. Earliest Priority Date Claimed
<u>PCT/JP98/03918</u> 1 country code	02 September 1998 Day MONTH Year	<u>02 September 1997</u> Day MONTH Year (use item 2 if no earlier priority)

4. Measured from the earliest priority date in item 3, this PCT/USA National Phase Application Request is being filed within:

(a) ☐ 20 months from above item 3 date (b) ☒ 30 months from above item 3 date,

(c) Therefore, the due date (unextendable) is March 2, 2000

5. Title of Invention FINE HOLLOW POWDER, THIN FLAKY TITANIUM OXIDE POWDER OBTAINED BY PULVERIZATION OF THE FINE HOLLOW POWDER AND PROCESSES FOR PRODUCING THE SAME

6. Inventor(s) Takayoshi SASAKI; Mamoru WATANABE; Yuichi MICHIE; Masaki IIDA

Applicant herewith submits the following under 35 U.S.C. 371 to effect filing:

7. ☒ Please immediately start national examination procedures (35 U.S.C. 371 (f)).

8. ☐ A copy of the International Application as filed (35 U.S.C. 371(c)(2)) is transmitted herewith (file if in English but, if in foreign language, file only if not transmitted to PTO by the International Bureau) including:

- a. ☐ Request;
- b. ☐ Abstract;
- c. pgs. Spec. and Claims;
- d. sheet(s) Drawing which are ☐ informal ☐ formal of size ☐ A4 ☐ 11"

9. ☒ A copy of the International Application has been transmitted by the International Bureau.

10. A translation of the International Application into English (35 U.S.C. 371(c)(2))

- a. ☐ is transmitted herewith including: (1) ☐ Request; (2) ☐ Abstract;
(3) 45 pgs. Spec. and Claims;
(4) 11 sheet(s) Drawing which are:
☐ informal ☒ formal of size ☒ A4 ☐ 11"
- b. ☐ is not required, as the application was filed in English.
- c. ☐ is not herewith, but will be filed when required by the forthcoming PTO Missing Requirements Notice per Rule 494(c) if box 4(a) is X'd or Rule 495(c) if box 4(b) is X'd.
- d. ☐ Translation verification attached (not required now).

RE: USA National Filing of PCT/JP98/03918

11. ☒ **PLEASE AMEND** the specification before its first line by inserting as a separate paragraph:
 a. ☒ --This application is the national phase of international application PCT/JP98/03918 filed 2 September 1998 which designated the U.S.--
 b. ☐ --This application also claims the benefit of U.S. Provisional Application No. 60/____, filed ____--
12. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)), i.e., before 18th month from first priority date above in item 3, are transmitted herewith (file only if in English) including:
13. ☒ PCT Article 19 claim amendments (if any) have been transmitted by the International Bureau
14. ☐ Translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)), i.e., of claim amendments made before 18th month, is attached (required by 20th month from the date in item 3 if box 4(a) above is X'd, or 30th month if box 4(b) is X'd, or else amendments will be considered canceled).
15. **A declaration of the inventor (35 U.S.C. 371(c)(4))**
 a. ☒ is submitted herewith ☒ Original ☐ Facsimile/Copy
 b. ☐ is not herewith, but will be filed when required by the forthcoming PTO Missing Requirements Notice per Rule 494(c) if box 4(a) is X'd or Rule 495(c) if box 4(b) is X'd.
16. **An International Search Report (ISR):**
 a. Was prepared by ☐ European Patent Office ☒ Japanese Patent Office ☐ Other
 b. ☒ has been transmitted by the international Bureau to PTO.
 c. ☒ copy herewith (3 pg(s).) ☐ plus Annex of family members (__ pg(s).)
17. **International Preliminary Examination Report (IPER):**
 a. ☒ has been transmitted (if this letter is filed after 28 months from date in item 3) in English by the International Bureau with Annexes (if any) in original language.
 b. ☐ copy herewith in English.
 c.1 ☐ IPER Annex(es) in original language ("Annexes" are amendments made to claims/spec/drawings during Examination) including attached amended:
 c.2 ☐ Specification/claim pages #__ claims #
 Dwg Sheets #
 d. ☐ Translation of Annex(es) to IPER (required by 30th month due date, or else annexed amendments will be considered canceled).
18. **Information Disclosure Statement including:**
 a. ☒ Attached Form PTO-1449 listing documents
 b. ☒ Attached copies of documents listed on Form PTO-1449
 c. ☒ A concise explanation of relevance of ISR references is given in the ISR.
19. ☒ **Assignment** document and Cover Sheet for recording are attached. Please mail the recorded assignment document back to the person whose signature, name and address appear at the end of this letter.
20. ☐ Copy of Power to IA agent.
21. ☐ **Drawings** (complete only if 8d or 10a(4) not completed): __ sheet(s) per set: ☐ 1 set informal; ☐ Formal of size ☐ A4 ☐ 11"
22. ☐ __ (No.) **Verified Statement(s)** establishing "small entity" status under Rules 9 & 27
23. **Priority** is hereby claimed under 35 U.S.C. 119/365 based on the priority claim and the certified copy, both filed in the International Application during the international stage based on the filing in (country) Japan of:
- | | <u>Application No.</u> | <u>Filing Date</u> | | <u>Application No.</u> | <u>Filing Date</u> |
|-----|------------------------|-------------------------|-----|------------------------|-------------------------|
| (1) | <u>09-254266</u> | <u>2 September 1997</u> | (2) | <u>09-254267</u> | <u>2 September 1997</u> |
| (3) | <u>09-254268</u> | <u>2 September 1997</u> | (4) | <u>09-364908</u> | <u>18 December 1997</u> |
| (5) | <u>09-364909</u> | <u>18 December 1997</u> | (6) | <u>10-030541</u> | <u>27 January 1998</u> |
| (7) | <u>10-030542</u> | <u>27 January 1998</u> | | | |
- a. ☒ See Form PCT/IB/304 sent to US/DO with copy of priority documents. If copy has not been received, please proceed promptly to obtain same from the IB.
- b. ☒ Copy of Form PCT/IB/304 attached.

RE: USA National Filing of PCT/JP98/03918

24. Attached: Preliminary Amendment; PTO-1449; References; IB308

25. Preliminary Amendment:

25.5 Per Item 17.c2, cancel original pages #__, claims #__, Drawing Sheets #26. **Calculation of the U.S. National Fee (35 U.S.C. 371 (c)(1)) and other fees is as follows:**Based on amended claim(s) per above item(s) ☐ 12, ☐ 14, ☐ 17, ☐ 25, ☐ 25.5 (hilit)

Total Effective Claims	27	minus 20 =	7	x \$18/\$9	=	\$126	966/967
Independent Claims	6	minus 3 =	3	x \$78/\$39	=	\$234	964/965
If any proper (ignore improper) Multiple Dependent claim is present,				add \$260/\$130	+	0	968/969

BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(4)): → → **BASIC FEE REQUIRED, NOW** → → → →A. If country code letters in item 1 are not "US", "BR", "BB", "TT", "MX", "IL", "NZ", "IN" or "ZA"

See item 16 re:

1. Search Report was <u>not</u> prepared by EPO or JPO -----	add \$970/\$485		960/961
2. Search Report was prepared by EPO or JPO -----	add \$840/\$420	+840	970/971

SKIP B, C, D AND E UNLESS country code letters in item 1 are "US", "BR", "BB", "TT", "MX", "IL", "NZ", "IN" or "ZA"

→ ☒ B. If USPTO did not issue both International Search Report (ISR) and (if box 4(b) above is X'd) the International Examination Report (IPER), ----- add \$970/\$485 +970 960/961

(only) (one) → ☐ C. If USPTO issued ISR but not IPER (or box 4(a) above is X'd), ----- add \$690/\$345 +0 958/959

(these) (4) → ☐ D. If USPTO issued IPER but IPER Sec. V boxes not all 3 YES, ----- add \$670/\$335 +0 956/957

(boxes)

→ ☐ E. If international preliminary examination fee was paid to USPTO and Rules 492(a)(4) and 496(b) satisfied (IPER Sec. V all 3 boxes YES for all claims), ----- add \$96/\$48 +0 962/963

27. SUBTOTAL = \$ 2170

28. If Assignment box 19 above is X'd, add Assignment Recording fee of ---\$40 +40 (581)

29. Attached is a check to cover the ----- TOTAL FEES \$ 2210

Our Deposit Account No. 03-3975

Our Order No. 11453 266927

C#

M#

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 and 492 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown above for which purpose a duplicate copy of this sheet is attached.

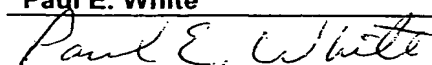
This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed

Pillsbury Madison & Sutro LLP
Intellectual Property Group

1100 New York Avenue, NW
 Ninth Floor
 Washington, DC 20005-3918
 Tel: (202) 861-3000
 Atty/Sec: PEW/MJG

By Atty: Paul E. White

Sig:



Reg. No. 32011

Fax: (202) 822-0944
 Tel: (202) 861-3651

NOTE: File in duplicate with 2 postcard receipts (PAT-103) & attachments.

Confirmation Report - Memory Send



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Name : MANELLI DENISON + SELTER PLLC

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Attorneys at Law
2000 M Street, 7th Floor, N.W.
Washington, DC 20036-3307

Telephone: 202-261-1050
Our Facsimile #: 202-887-0336

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TO: UNITED STATES PATENT AND TRADEMARK OFFICE

TO: Examiner Hoa T. Le
Art Unit: 1773

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In re PATENT APPLICATION of
Inventor(s) SASAKI et al.
Appln. No. 09/516,176
series code serial no.
Filed: March 1, 2000

Group Art Unit: 1773
Examiner: Hoa T. Le

Atty. Dkt. FEW/46137

TITLE: Ink-Jet Recording Material And Ink-
Jet Recording Method

Date: October 30, 2002

Name or type of paper being transmitted: Copy of Application Transmittal Papers
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Forms Directory PAT-286 Rear. DO NOT file originals but E-mail them in our file (left side) with
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent
and Trademark Office on the date shown below.

Name Paul E. White, Jr. Sig. *Paul E. White, Jr.* Date October 30, 2002

Req. No. 32,011

FEW/46137

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